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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,469	05/25/2005	Peter A Muller	123884	5174
25944	7590	02/09/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			SWINEHART, EDWIN L	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/536,469

Applicant(s)

MULLER, PETER A

Examiner

Ed Swinehart

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-19 are objected to because of the following informalities: In claim 1, "the underwater transmission" lacks proper antecedent basis in the claim. Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, "possibly" renders the metes and bounds of the claim difficult to determine.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims a operability as jet drive, yet fails to disclose same. There has been disclosed no nozzle, or even an impeller, therefore operation as a "jet drive" is unclear.

Operation in the upper position is not understood. As illustrated and discussed with re to figure 13a for example, the waterline is illustrated such that in the upper position, the propeller is above the waterline. How then is propulsion possible?

The claimed open and/or closed tunnel has not been disclosed. How is the tunnel provided with a simultaneous open and closed state?

How is the tunnel simultaneously arranged on the side and bottom?

Without complete and adequate disclosure of the invention, one of ordinary skill in the art could not make and/or use same.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gillois.

Gillois discloses the claimed invention, including an engine, exteriorly mounted transmission, and propeller. The exteriorly mounted components being laterally pivotal about "pivoting means". Since there is no disconnectivity in the drive train, such a propeller is operable at positions other than the lowermost position.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Shallbetter.

Shallbetter discloses the claimed invention, including a Z-drive transmission and propeller/impeller which is laterally swingable as claimed. The shroud will enable functioning as a waterjet.

9. Claims 1-4,10-12,14-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by McCormick.

McCormick discloses a propulsion unit which is both laterally swingable about a longitudinal axis, and about a vertical axis caused by movement of the steering wheel.

Re claim 14, since the motor speed is controlled by a user actuated throttle, its speed is inherently adapted to be adjustable as claimed.

Re claim 15, such fails to define over the skeg of the lower unit.

Re claim 16, such fails to define over rotation about a longitudinal axis.

Re claims 10 and 19, "in case" is not a positive recitation of structure at all, and such associated structure is accorded no weight in the claims.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shallbetter in view of Kobayashi.

Shallbetter fails to disclose a water intake located within the hull.

Kobayashi teaches provision of an opening within and through the hull which aligns with the propeller of a swingable outdrive.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Shallbetter with water passages through the hull as taught by Kobayashi.

Such a combination would have been desirable at the time of the invention so as to provide improved efficiency and protection for the drive.

12. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shallbetter in view of Kobayashi as applied to claim 5 above, and further in view of Dusablon et al.

Shallbetter fails to disclose a flap valve.

Dusablon teaches provision of a flap valve.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Shallbetter with a flap valve as taught by Dusablon.

Such a combination would have been desirable at the time of the invention so as to provide improved efficiency.

Re claim 9, the thruster of Shallbetter may be swung to provide lateral thrust.

13. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick as applied to claim 1 above, and further in view of James.

McCormick fails to disclose hydraulic lines as claimed

James teaches a hydraulic motor within his lower unit.

It would have been obvious to one of ordinary skill in the art at the time of the invention to power the propeller of McCormick via hydraulics as taught by James.

Such a combination would have been desirable at the time of the invention so as to provide a more simplistic transmission of power.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Swinehart whose telephone number is 571-272-6688. The examiner can normally be reached on Monday through Thursday 6:30 am to 2:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ed Swinehart
Primary Examiner
Art Unit 3617